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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/594,049	06/20/2007	Jody Stallings	50642/335252	8962
30559	7590	06/10/2009	EXAMINER	
DIANA HOUSTON SMITH & NEPHEW, INC. 1450 BROOKS ROAD MEMPHIS, TN 38116			FONTENOT, NIGEL RAI	
			ART UNIT	PAPER NUMBER
			3768	
			MAIL DATE	DELIVERY MODE
			06/10/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/594,049	STALLINGS ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	NIGEL FONTENOT	3768	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 25 September 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 September 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>2/5/2007, 4/25/2007, 5/29/2007, 10/12/2007,</u>               | 6) <input type="checkbox"/> Other: _____                          |
| <u>12/17/2007, 5/9/2008, 8/11/2008, 11/14/2008, 2/12/2009.</u>                         |   |



### **DETAILED ACTION**

This action is responsive to the application filed September 25, 2006.

Preliminary amendment filed Sept. 25, 2006 has been entered. Claims 1-16 are pending.

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2. Claims 1, 3-5, and 7-16 rejected under 35 U.S.C. 102(e) and 35 U.S.C. 102(a) as being anticipated by Couture et al. (WO 2004/017842).

3. Addressing claims 1 and 5, Couture discloses a system and device for computer aided surgery navigation (see fig. 1) which includes a sensor adapted to sense position of a plurality of indicia attached by a reference frame to an item used in surgery and a computer functionality adapted to receive information from the sensor about position of the indicia and generate information corresponding to position and orientation of the item to which the indicia are attached (see p. 10 lines 15-32 and p. 11 lines 1-12): wherein the indicia are attached to the item using at least one registering and securing mechanism such that the indicia may attach only in a determined position and so that the indicia may be removed from the item and reattached without incorrect registration relative to the item; and wherein the registering and securing mechanism features a structure which allows the indicia to be selectively attached and detached from the item (see (17) and (10) in figs. 1-2 and p. 12 lines 3-18).

4. Addressing claims 3, 4, 7, and 8, Couture discloses the registering and securing mechanism comprises a separate registering mechanism and a separate securing mechanism, the registering and securing mechanism comprises at least one of a ball plunger, a retractable plunger, a male pin and female receptor, or a magnetic device (see p. 12 lines 19-32, p. 13 lines 1-16, and fig. 6).

5. Addressing claims 9-10, 13, and 16, Couture discloses all the limitations of claims 1 and 5 above. Further Couture discloses device and process for use in a computer aided surgical navigation system, the system including a sensor adapted to sense position of a plurality of indicia attached by a reference frame to an item used in surgery; computer functionality adapted to receive information from the sensor about position of the indicia and generate information corresponding to position and orientation of the item to which the indicia are attached, including: a reference frame adapted to be connected to the item; at least one indicium connected to the reference frame; and an adjustable securing mechanism interposed between at least one indicium and the item, wherein the adjustable securing mechanism is configured such that the indicia may attach in a variety of rigidly fixed orientations relative to the item, and wherein the adjustable securing mechanism features structure which allows the indicium to be selectively repositioned and resecured relative to the item (see p. 1 lines 16-24, p. 12 lines 3-18, p. 14 lines 14-32, p. 15 lines 1-8, and figs. 1-3 and 6).

6. Addressing claims 11 and 14, Couture discloses at least one of the indicia includes a fiducial or an active device (see p. 11 lines 17-24 and p. 14 lines 14-23).

7. Addressing claims 12 and 15, Couture discloses the adjustable securing mechanism includes an adjustable rod with a base thumb screw for securing the adjustable rod (see p. 12 lines 3-18 and p. 14 lines 1-13).

8. Claims 1-2, 5-6, 9-10, 13, and 16 are rejected under 35 U.S.C. 102(e) as being anticipated by Rossner et al. (US 2003/0225329).

9. Addressing claims 1, 5, 9-10, 13 and 16, Rossner discloses a device, system and process for use in a computer aided surgical navigation system including a sensor adapted to sense position of a plurality of indicia attached by a reference frame to an item used in surgery, and computer functionality adapted to receive information from the sensor about position of the indicia and generate information corresponding to position and orientation of the item to which the indicia are attached comprising: a reference frame to which the indicia may be attached, the reference frame adapted to be connected to the item; a registering and securing mechanism interposed between at least one indicium and the item; wherein the indicia may only attach in a determined position so that they may be removed from the item and reattached without incorrect registration of the indicia relative to the item; and wherein the registering and securing mechanism includes a structure which allows the indicia to be selectively attached and detached from the item (see figs. 1-2 and paras 21-24 and 27).

10. Addressing claims 2 and 6, Rossner discloses wherein at least one of the indicia includes a reflective surface adapted to be sensed by an infrared sensor device or a transponder that emits energy when interrogated (see paras 20-22).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to NIGEL FONTENOT whose telephone number is (571)270-7032. The examiner can normally be reached on Monday-Friday (7:00a-4:00p).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Long Le can be reached on 571-272-0823. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/N. F./  
Examiner, Art Unit 3768

/Long V Le/  
Supervisory Patent Examiner, Art Unit 3768